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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,792	06/22/2001	Tobias Meyer	0459-0570P	9673

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EXAMINER
BHATTI, TAHIRA H

ART UNIT	PAPER NUMBER
1627	6

DATE MAILED: 12/12/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/787,792	MEYER, TOBIAS	
	Examiner	Art Unit	
	Tahira H Bhatti	1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-45* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1-45 currently are pending

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6 and 8-25 , drawn to a method of detecting a protein-protein interaction in a cell, classified in class 436, subclass 500

II. Claims 7, drawn to method of inhibition of specific binding pair by the test compound, classified in class 435, subclass 7.71.

III. Claim 26 drawn to a fusion protein that specifically binds to an internal structure, classified in class 424 subclass 194.1

IV Claim ,27 and 28 drawn to a nucleic acid encoding a fusion protein, classified in class 536, subslass 23.4

V. Claim 29 drawn to a fusion protein comprising a detectable protein and a translocatable protein, classified in class 424 class 195.11

VI Claim s 30 and 31 drawn to nucleic acid encoding a fusion protein classified in class 536, subclass 23.4

VII Claims 32-35 drawn to a kit for detecting protein-protein interaction within a living cell, classified in class 436, subclass 808.

VIII Claim 36-45, drawn to nucleic acid library classified in class 536, subclass 23.1.

Inventions I and II are drawn to independent and/or distinctly different methods, which can be used to make different product, have different objectives, utilize different reagents and encompass the use of independent and/distinctly different protocol.

Inventions III and V drawn to a fusion protein, having different chemical structure and/or different physiochemical properties, which are capable of separate manufacture and/or use and which require separate and/or divergent manual/computer search, bibliographic patent and non-patent literature searches that are separately and individually burdensome

Inventions I, II, III and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case)). In the instant case group I, II, III and group V are independent inventions, because they are physically and functionally distinct chemical entities, and the method of detecting a protein-protein interaction can be done by another and materially different process, and method used in the claims can detect other protein interactions which are materially of different composition and length.

Groups IV and VI are directed to nucleic acid, encoding a fusion proteins, whereas invention VIII is directed to a nucleic acid library. Inventions IV, VI and VIII are distinct and/or independent groups of nucleic acids, encoding different types of fusion proteins and peptides.

Inventions I or II and III, or V and IV, or VI, or VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, these inventions are independent and/or distinct since these individual groups utilize independent and/or patentably distinct recombinant methods due to methods, which differ in objective (synthesis of independent and/or distinctly different proteins) and/or the use of independent and/or distinct DNA sequences

Groups VII drawn to a kit for detecting protein-protein interaction, which is distinct and independent and can be used separately and does not require the particular of any other groups (e.g. I or II), and It can be practiced with another materially different products such as the use of different peptides or proteins of different sequences, and length as to be chemically independent and/or distinct.

Because these inventions are distinct for the reasons given above:

a. And have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification.

b. Require different and independent burdensome manual/computer patent and non-patent literature searches, restriction for examination purpose as indicated is proper.

ELECTION OF SPECIES

This application contains claims directed to the following patentably distinct species of the claimed invention: Translocatable proteins (Group V), nucleic acid encoding fusion proteins (Group IV and VI), and nucleic acid library (Group VIII).

These Groups encompass peptides and nucleotides that are drawn to distinct and independent and/or patentably distinct inventions, due to differences in their chemical structure and physiological, biochemical and chemical properties, that are capable of separate manufacture and/or use; and each individual compound would use distinct methods steps, would have different object of producing it, and require separate and/or divergent manual/computer search, bibliographic patent and non-patent literature searches which are separately and individually burdensome.

Accordingly, applicant is required under 35 U.S.C. 121 to elect

(a) For group V a specific translocatable protein.

(b) For group IV and VI a single DNA sequence for encoding a specific fusion protein

(c) For group VIII a single nucleic acid, from the nucleic acid library.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tahira Bhatti whose telephone number is (703) 605-1203.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsana Venkat (art unit 1627), can be reached at (703) 308 0570

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (702) 308-0196

Tahira Bhatti (art unit 1627)
DEC. 7th, 2001

BENNETT CELSA
PRIMARY EXAMINER